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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,987	12/31/2001	Stephane H. Maes	YOR920010471US1(8728-534)	9604
46069	7590	02/09/2005	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			WORJLOH, JALATEE	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 02/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,987

Applicant(s)

MAES, STEPHANE H.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed on December 2, 2004, in which claims 1, 18, 25 and 26 were amended.

Response to Arguments

2. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.
3. Claims 1-27 have been examined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 6-9, 10-16, 18, 21-24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5903878 to Talati et al. in view of US Publication No. 2004/0260653 to Tsuei et al.

Talati et al. disclose performing an electronic transaction between a first party (i.e. "client" and a second party (i.e. "merchant"), sending by the second party, a request for confirmation of the electronic transaction to a predetermined, private mailbox (i.e. ECS)

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associated with the first party (see col. 10, lines 53-67), accessing the private mailbox by the first party (see col. 11, lines 2-4) and sending, by the first party, a reply message to the request for confirmation to thereby confirm authorization of the electronic transaction (see col. 11, lines 11-21). Talati et al. do not expressly disclose the method wherein information regarding the private mailbox is not communicated to the second party during the electronic transaction. Tsuei et al. disclose the method wherein information regarding the private mailbox (i.e. the true address of the mailbox) is not communicated to the second party (i.e. "merchant") during the electronic transaction (see paragraph [0026], lines 1-5). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the process wherein information regarding the private mailbox is not communicated to the second party during the electronic transaction. One of ordinary skill in the art would have been motivated to do this because it reduces or eliminates fraud by protecting the identity of consumers when a transaction include shipping or mailing to consumers (see paragraph [0011] of Tsuei et al.).

Referring to claim 2, Talati et al. disclose sending, by the second party, a request for confirmation (see claim 1 above). Talati et al. does not explicitly disclose the step of sending a request for confirmation comprises the step of contacting, by the second party, a third party service provider to obtain the location of the predetermined, private mailbox. However, this is an inherent step; that is, the merchant contacts the third party (i.e. CA), who in turns transmits the confirmation message to the client. Before transmission of the message, the mailbox location must first be obtained (see col. 10, lines 53-57).

Referring to claims 6 and 8, Talati et al. disclose sending a reply message comprises sending an e-mail message to a predetermined location (i.e. CA at the ECS); wherein the step of sending a reply message comprises forwarding the confirmation message to a predetermined location (see col. 11, lines 11-20).

Referring to claim 7, Talati et al. disclose the e-mail message comprises a confirmation code (i.e. "UTID") provided in the notification message (see col. 10, lines 30-36).

Referring to claims 9 and 21, Talati et al. disclose sending a confirmation request (see claim 1 above). Talati et al. do not expressly disclose imposing a time period in which the first party must confirm authorization of the electronic transaction. Tsuei et al. disclose imposing a time period (i.e. message timer) in which the first party must confirm authorization of the electronic transaction (see paragraph [0085], lines 55-61). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the step of imposing a time period in which the first party must confirm authorization of the electronic transaction. One of ordinary skill in the art would have been motivated to do this because it ensures that the transaction is processed quickly by eliminating transaction delays.

Referring to claims 10 and 22, Talati et al. disclose accessing the private mailbox comprises authenticating the identity of the first party to access the private mailbox (see col. 10, lines 61-67; col. 11, lines 1-3).

Referring to claim 11, Talati et al. disclose authenticating the identity of the first party comprises performing biometric (i.e. signature) authentication of the first party (see col. 6, lines 25-32).

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Referring to claim 12, Talati et al. disclose authenticating the identity of the first party comprises providing a predetermined PIN (personal identification number) or password of the first party (see col. 10, lines 64-67; col. 11, lines 1,2).

Referring to claims 13 and 23, Talati et al. disclose the step of encoding the confirmation request and reply message (see col. 10, lines 61-64).

Referring to claims 14 and 15, Talati et al. disclose the private mailbox comprises a messaging system; wherein the messaging system comprises one of e-mail, short messaging, multimedia messaging, instant messaging, voice mail and universal messaging system (see col. 10, lines 10-13 and col. 11, lines 11-20).

Referring to claim 16, Talati et al. disclose the private mailbox comprises a post office box and the confirmation is send via snail mail (see col. 1, lines 56-59).

Referring to claim 18, Talati et al. disclose performing an electronic transaction between a first party (i.e. "client" and a second party (i.e. "merchant"), providing, by the second party to the third party service provider (i.e. "CA"), a request for confirmation of the electronic transaction, sending, by the third party service provider, the request for confirmation of the electronic transaction to a predetermined, private mailbox (i.e. ECS) associated with the first party (see col. 10, lines 53-67), accessing the private mailbox by the first party (see col. 11, lines 2-4) and sending, by the first party, a reply message to the request for confirmation to thereby confirm authorization of the electronic transaction (see col. 11, lines 11-21). The step of providing, by the first party to the second party, contact information of a third party service provider associated with the first party is an inherent step; that is, in order for the second party to provide information to the third-party, the second party must have received contact information

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of the third party. Talati et al. do not expressly disclose the method wherein information regarding the private mailbox is not communicated to the second party during the electronic transaction. Tsuei et al. disclose the method wherein information regarding the private mailbox (i.e. the true address of the mailbox) is not communicated to the second party (i.e. "merchant") during the electronic transaction (see paragraph [0026], lines 1-5). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the process wherein information regarding the private mailbox is not communicated to the second party during the electronic transaction. One of ordinary skill in the art would have been motivated to do this because it reduces or eliminates fraud by protecting the identity of consumers when a transaction include shipping or mailing to consumers (see paragraph [0011] of Tsuei et al.).

Referring to claim 24, Talati et al. disclose a second party and third party (see claim 18 above). Talati et al. do not expressly disclose the second party and third party service provider are the same entity. However, modifying the invention to include such feature will not alter the scope of the invention. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the second and third party as the same entity. One of ordinary skill in the art would have been motivated to do this because it makes the transaction process faster by eliminating an additional entity.

Referring to claim 25, Talati et al. disclose performing an electronic transaction between a first party (i.e. "client" and a second party (i.e. "merchant") and sending by the second party, a confirmation message of the electronic transaction to a predetermined, private mailbox (i.e. ECS)

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associated with the first party (see col. 10, lines 53-67). Talati et al. do not expressly disclose wherein the electronic confirmation is deemed confirmed if a reply message denying the transaction is not sent by the first party within a predetermined period of time or the method wherein information regarding the private mailbox is not communicated to the second party during the electronic transaction. Tsuei et al. disclose imposing a time period on the delivered mail (see paragraph [0085], lines 55-61). The examiner notes that Tsuei et al. teach the overall process of including a timer in the delivered request; thereby, any other conditions (i.e. the confirmation being deemed confirmed) can be implied. Thus, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the step wherein the electronic confirmation is deemed confirmed if a reply message denying the transaction is not sent by the first party within a predetermined period of time. One of ordinary skill in the art would have been motivated to do this because it ensures that the transaction is processed quickly by eliminating transaction delays.

6. Claims 3-5, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. and Tsuei et al. as applied to claims 1 and 18 above, and further in view of US Publication No. 2001/0037464 to Persels et al.

Referring to claims 3 and 19, Talati et al. disclose sending a notification of newly received email messages (see col. 10, lines 10-15). Talati et al. do not expressly disclose sending notification to the first party of a pending request for confirmation. Persels et al. disclose sending notification to the first party of a pending request for confirmation (see paragraph [0020]). At the time the invention was made, it would have been obvious to a person of ordinary

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skill in the art to modify the notification disclose by Talati et al. to inform the receiver of pending confirmation request. One of ordinary skill in the art would have been motivated to do this because it provides adequate customer services by informing the first party of pending confirmation request.

Referring to claim 4, Talati et al. disclose the method wherein the notification comprises a confirmation code (i.e. "UTID") to be provided in the reply message (see col. 10, liens 53-60; col. 11, liens 27-32).

Referring to claims 5 and 20, Talati et al. disclose the method wherein the step of sending notification comprises sending a notification message by the second party to a predetermined messaging location of the first party other than the private mailbox of the first party (see col. 10, lines 53-60).

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. and Tsuei et al. as applied to claim 1 above, and further in view of US Publication No. 2003/0018572 to Beschle et al.

Talati et al. disclose the private mailbox (see claim 1 above). Talati et al. do not expressly disclose the mailbox comprises a facsimile number and the confirmation message comprises a facsimile message. Beschle et al. disclose the mailbox comprises a facsimile number and the confirmation message comprises a facsimile message (see paragraph [0055]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the mailbox comprises a facsimile number and the confirmation message comprises a facsimile message. One of ordinary skill in

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the art would have been motivated to do this because it provides additional means for sending the confirmation message.

8. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. and Tsuei et al. as applied to claim 25 above, and further in view of US Publication No. 2001/004050 to Fletcher et al.

Referring to claim 26, Talati et al. disclose sending a notification of newly received email messages (see col. 10, lines 10-15). Talati et al. do not expressly disclose a confirmation message provides information regarding the predetermined period of time. Fletcher et al. disclose a confirmation message provides information regarding the predetermined period of time (see paragraph [0054]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include a notification message that provides information regarding the predetermined period of time. One of ordinary skill in the art would have been motivated to do this because it ensures that the transaction is processed quickly by eliminating response delays.

Referring to claim 27, Talati et al. disclose the step of sending a confirmation message (see claim 25 above). Talati et al. does not explicitly disclose the step of sending a request for confirmation comprises the step of contracting, by the second party, a third party service provider to obtain the location of the predetermined, private mailbox. However, this is an inherent step; that is, the merchant contracts the third party (i.e. CA), who in turns transmits the confirmation message to the client. Before transmission of the message the mailbox location must first be obtained (see col. 10, lines 53-57).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for Regular/After Final Actions and 703-746-9443 for Non-Official/Draft.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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PO Box 1450
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, V.A., Seventh floor receptionist.


Jalatee Worjloh
Patent Examiner
Art Unit 3621

February 3, 2005


JAMES P. TRAMMELL
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